

REMARKS

Reconsideration of this application is respectfully requested.

Claims 1 – 82 are pending in this application. Upon entry of this Amendment, claims 1, 7, 8, 14, 15, 19, 23, 27 – 50, 59 – 66 and 71 – 78 will be amended, claims 79 – 82 will be canceled and new claims 83 – 86 will be added.

In the outstanding Office Action of April 3, 2006, the Examiner rejected claims 1 – 82 under 35 U.S.C. §112, second paragraph, as being indefinite because of the limitation recited, for example, in independent claim 1 of "said a low resolution scan file providing a display with sufficient detail to allow recognition of at least products imaged on said catalog page." Independent claims 1, 8, 15, 19, and 47 – 50 have all been amended to delete the noted language and to recite - - a low resolution image file of a predefined size for providing a low resolution image of a catalog page - -. Dependent claims 7, 14, 23, 27 – 46, 59 – 66 and 71 – 78 have been amended to conform the language of such claims to the language of the amended independent claims. New claims 83 – 86 have also been added to further describe the predefined size as being in the range of 20 to 30 K bytes. Support for new claims 83 – 86 appears at least at page 7 of the application specification. In view of the foregoing amendments to the above-noted claims, the Examiner's rejection of claims 1-78 under §112, second paragraph, should now be withdrawn.

In the outstanding Office Action, the Examiner also rejected claims 1 – 82 under 35 U.S.C. §103(a) as being unpatentable over the archived website www.harolds.com

(hereinafter “Harolds”) in view of Parulski *et al.* (USP 5,440,401) (hereinafter “Parulski”) in further view of Image Splitter (hereinafter “Image Splitter”). In his rejection, the Examiner is relying on the version of the Harolds website archived at www.archive.org on June 30, 1998 and the version of the Image Splitter website archived at www.archive.org on October 27, 2001. The Examiner's §103(a) rejection is respectfully traversed.

For a claimed invention to be obvious over a combination of prior art references, the Federal Circuit has held that there must be some suggestion, motivation or teaching in the prior art that would have led one of ordinary skill in the art to combine the references to produce the claimed invention. *E.g., Ashland Oil, Inc. v. Delta Resins & Refracs.*, 776 F.2d 281, 293 (Fed. Cir. 1985). In this regard, the Federal Circuit has warned against using a claimed invention as a “blueprint” for piecing together elements in the prior art to defeat the patentability of a claimed invention:

As this court has stated, “virtually all [inventions] are combinations of old elements.” . . . Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.”

In re Rouffet, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). (Citations omitted). The Federal Circuit has identified three possible sources for a motivation to combine references and

thereby prevent the use of hindsight based on the invention to defeat patentability of the invention:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the matter claimed. This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.

In re Rouffet, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998).

In combining the Harolds, Parulski and Image Splitter references to reject claims 1 – 82 under §103(a), the Examiner asserts that "one of ordinary skill in the art would have been motivated to modify Harolds to add the low resolution scan generation teaching that the Examiner contends Parulski discloses to speed up download times and the split image teaching that the Examiner contends the Image Splitter reference discloses to speed up loading of images. April 3, 2006 Office Action, pages 4 through 6. It is respectfully submitted that, in combining the Harolds, Parulski and Image Splitter references, the Examiner is using hindsight and the claimed invention as a "blueprint" for piecing together elements in the prior art to defeat the patentability of the claimed invention. As such, Applicant respectfully contends that the Examiner has not met his burden of identifying some suggestion, motivation or teaching in the prior art that would have led

one of ordinary skill in the art to combine the references to produce the claimed invention.

But, even assuming, *arguendo*, that the Examiner properly combined the cited Harolds, Parulski and Image Splitter references, the result would not be the invention of the present application, as described in independent claims of the present application.

In the present application, independent claims 1, 8, 15, 19 and 47 – 50 are directed to either a method or a system for browsing a product catalog via the Internet or a telecommunications network. Amended independent claims 1, 8, 15, 19 each recites a separate a low resolution image for each page of a product catalog, and a separate detailed product presentation for each product displayed on the low resolution scan of each catalog page. Independent claims 1, 8, 15, 19 and 47 – 50, each recites a detailed product presentation comprising (a) at least a high resolution photograph of the product, and (b) an order data block containing (i) at least one entry of ordering information for the product and (ii) a corresponding link for each ordering information entry for directly purchasing the product. The references cited by the Examiner to support his §103(a) rejection do not render independent claims 1, 8, 15, 19 and 47 – 50 unpatentable because they do not disclose at least the foregoing features of the claimed invention.

In the outstanding Office Action, the Examiner acknowledges that the “low resolution scan” example identified by the Examiner, *i.e.*, pages 2-7 of “Harolds' Ladies Catalog”, grouped into three groupings as pages 2-3, pages 4-5, and pages 6-7, do not disclose a separate a low resolution image for each page of a product catalog, since they

actually corresponds to two catalog pages. The Examiner seeks to cure this deficiency in the teachings of Harolds by citing the Image Splitter product to split the two catalog pages of Harolds into two separate scan files for each page. While Applicant submits that the Examiner is using hindsight in proposing this "solution", nevertheless, the result is still not the invention as described in independent claims 1, 8, 15, 19, which recite a low resolution image file of a predefined size for providing a separate low resolution image of each catalog page. Even if it were obvious to combine the Image Splitter product with Harolds, the result would still be a low resolution image of the two catalog pages, since the Image Splitter product states:

You can select method of fragmentation. **Your resulting picture looks exactly equal to the original during seamless integration of slices.** User's Internet browser will load slices of the picture simultaneously!

Image Splitter 1.36 (Emphasis added). Thus, the result would still be a display of the two pages originally displayed by Harolds.

The references cited by the Examiner do not render unpatentable claims 1, 8, 18 and 19 because they also do not disclose a separate detailed product presentation for each product imaged on the low resolution scan of each catalog page. The "detailed product presentation" example identified by the Examiner (pages 12 of 13 and 13 of 13) corresponding to the products shown on catalog pages 2 – 3 actually corresponds to two products shown on these catalog pages, *i.e.*, a "Cartoon Daffodil Skirt" and a "Rayon Crepe Twin Set". Although the "low resolution scan" example of Harolds' catalog pages

2 – 3 includes more than one product image, it is not possible to pull up a separate “detailed product presentation” for each product image on these pages. It is only possible to click on catalog pages 2 and 3 simultaneously, which produces the multi-product “detailed” presentation identified by the Examiner as pages 11 of 13 and 12 of 13 of the cited Harolds website. Thus, for at least these reasons, independent claims 1, 8, 15 and 19 are not unpatentable over the cited references.

The references cited by the Examiner also do not render unpatentable independent claims 1, 8, 15, 19 and 47 – 50 because they do not disclose a “detailed product presentation” comprising (a) at least a high resolution photograph of a product, and (b) an order data block containing (i) at least one entry of ordering information for the product and (ii) a corresponding link for each ordering information entry for directly purchasing the product, as recited in independent claims 1, 8, 15, 19 and 47 – 50. The “detailed product presentation” identified by the Examiner as pages 12 of 13 and 13 of 13 of the cited Harolds website bears a notation "Ipage2a.GIF (30366 bytes)". While this notation may correspond to a GIF file that was not archived, it is impossible to tell from the archive pages cited by the Examiner what image would have actually appeared with the descriptions of the "Cartoon Daffodil Skirt" and the "Rayon Crepe Twin Set" set forth on pages 12 of 13 and 13 of 13 of the cited Harolds website. Thus, it is not clear that the “detailed product presentation” for catalog pages 2 and 3 includes a high resolution photograph of either or both of these products.

And while there is, on pages 12 of 13 and 13 of 13 of the cited Harolds website, information for each of the products corresponding to product sizes and prices, there are no links corresponding to such information for either of such products that allows a shopper to directly purchase a product, as recited in the independent claims of the present application. Rather, the “detailed product presentation” example cited by the Examiner simply states on page 13 of 13: “To order simply write this information down and order from our on-line form. Or call 1-800-676-5373.” Thus, the cited Harolds’ catalog requires the inconvenient and indirect steps of writing down product information before going to a separate on-line ordering form or calling the telephone number listed on the website page to purchase products. At best, Harolds teaches indirectly initiating a purchase, not even directly initiating a purchase, as argued by the Examiner. Thus, for at least these further reasons, Harolds does not anticipate independent claims 1, 8, 15, 19 and 47 – 50.

Since the references cited by the Examiner do not render unpatentable the independent claims 1, 8, 15, 19 and 47 – 50, they also do not render unpatentable the dependent claims which depend either directly or indirectly from these claims, *i.e.*, claims 2 – 7, 9 – 14, 16 – 18, 20 – 46, 51 – 78 and 83 – 86.

In view of the foregoing, it is believed that all of the claims pending in the application, *i.e.*, claims 1 – 78 and 83 – 86, are now in condition for allowance, which

action is earnestly solicited. If any issues remain in this application, the Examiner is urged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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